

Application No. 09/851,210

**REMARKS**

In response to the Office Action of April 1, 2006, Applicant has carefully considered the rejections of the Examiner in the above-identified application. In light of this consideration, Applicants believe that the claims as amended are allowable. Applicant respectfully requests reconsideration of the rejection of the claims now pending in the application.

In the first Office Action of December 1, 2004, claims 1 and 8 were rejected under 35 U.S.C. §112, first paragraph, as failing to comply with the enablement requirement. Claims 1-3 and 5-16 were rejected under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 5,390,035, to Kasson et al. (hereinafter Kasson) in view of U.S. Patent No. 5,982,990, to Gondek (hereinafter Gondek). Claim 4 was rejected under 35 U.S.C. §103(a) as being unpatentable over Kasson in view of Gondek and U.S. Patent No. 5,553,199, to Spaulding, et al. (hereinafter Spaulding).

In this Office Action of March 31, 2006, claims 1-16 are rejected under 35 U.S.C. §101 as directed to non-statutory subject matter. Claims 1-7 are rejected under 35 U.S.C. §112, second paragraph, as being indefinite. Claims 1-5 and 7-15 are rejected under 35 U.S.C. §102(e) as being anticipated by U.S. Application Publication No. 2001/0028471, to Hirokazu (hereinafter Hirokazu). Claim 6 is rejected under 35 U.S.C. §103(a) as being unpatentable over Hirokazu in view of U.S. Patent No. 5,185,661, to Ng (hereinafter Ng). Claim 16 is rejected under 35 U.S.C. §103(a) as being unpatentable over Hirokazu in view of Kasson.

Claims 1-16 are rejected under 35 U.S.C. §101 as directed to non-statutory subject matter. That rejection must be respectfully traversed as improper. Inks are very much to be included under that definitional umbrella provided as "anything under the sun that is made by man". Further an ink is clearly an item of manufacture. Further the claimed invention here directed to

Application No. 09/851,210

a methodology of combining various color inks, does not fall within one of the judicially created exceptions, and it is not directed to an abstract idea, natural phenomena, or law of nature. The claimed invention here is directed to a methodology of combining various color inks in a printing system, and is thus useful and directed to a practical application. Further, the claimed invention is drawn to how to best combine various color inks when the available number of ink colorants exceeds the normal four colorants CMYK so as to include at least one additional colorant ink.

The Examiner is directed to: "Interim Guidelines for Examination of Patent Applications for Patent Subject Matter Eligibility" to be found at: [http://www.uspto.gov/web/offices/pac/dapp/opla/preognotice/guidelines101\\_20051026.pdf](http://www.uspto.gov/web/offices/pac/dapp/opla/preognotice/guidelines101_20051026.pdf); and in particular page 16 thereof where it is stated:

"If the invention as set forth in the written description is statutory, but the claims define subject matter that is not, the deficiency can be corrected by an appropriate amendment of the claims. In such a case, USPTO personnel should reject the claims drawn to nonstatutory subject matter under 35 U.S.C. § 101, but identify the features of the invention that would render the claimed subject matter statutory if recited in the claim."

This last item, as bolded, italicized, and underlined, has not been done. If the Examiner wishes to provide such input, the Applicants are very willing to consider such a suggestion.

A prima facie case for a 35 U.S.C. §101 rejection has not been made out and thus the rejection is improper. The Applicants respectfully request withdrawal of the rejection.

Claims 1-7 are rejected under 35 U.S.C. §112, second paragraph, as being indefinite. It is believed that claim 1 as is currently amended overcomes this rejection and allowance of claims 1-7 is respectfully requested.

Claims 1-5 and 7-15 are rejected under 35 U.S.C. §102(e) as being anticipated by Hirokazu. Hirokazu is directed to providing proof print sheets

Application No. 09/851,210

representative of a rotary press and the like. Hirokazu does not tessellate color space into *regions*. Hirokazu provides sample discreet spot colors as printed upon a proof page, and as such provides points rather than continuous regions. The claims however, have been amended in view of the Examiner's argument that black is a redundant color. While the Applicant is of the firm conviction that one skilled in the art would never make such a confusion as to what is a redundant color, never-the-less, the claims have been amended to better point out and specify that invention which the Applicant considers to be his as taught by the specification.

It is therefore respectfully requested that the rejection of claims 1-5 and 7-15 as rejected under 35 U.S.C. §102(e) be withdrawn. Allowance of claims 1-3 and 5-16 is respectfully requested.

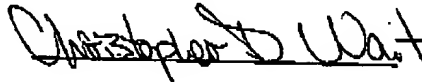
Claim 6 is rejected under 35 U.S.C. §103(a) as being unpatentable over Hirokazu in view of Ng. Claim 16 is rejected under 35 U.S.C. §103(a) as being unpatentable over Hirokazu in view of Kasson. Since claims 6 & 16 depend from claims deemed allowable they should be allowable as well. Allowance of claims 6 & 16 is respectfully requested.

Application No. 09/851,210

No additional fee is believed to be required for this amendment; however, the undersigned Xerox Corporation attorney authorizes the charging of any necessary fees, other than the issue fee, to Xerox Corporation Deposit Account No. 24-0025.

In the event the Examiner considers personal contact advantageous to the disposition of this case, he is hereby requested to call the undersigned attorney at (585) 423-6918, Rochester, NY.

Respectfully submitted,



Christopher D. Wait  
Attorney for Applicant(s)  
Registration No. 43,230  
Telephone (585) 423-6918

July 2, 2006  
CDW/fsl  
Xerox Corporation  
Xerox Square 20A  
Rochester, New York 14644